

REMARKS

A check in the amount of \$1742 for the Issue Fee for a large entity, Publication fee and an advance order of 14 copies of the issued patent accompanies this response. Any fees that may be due in connection with this paper or this application during its entire pendency may be charged to Deposit Account No. 06-1050. If a Petition for extension of time is needed, this paper is to be considered such Petition.

COMMENTS ON EXAMINER'S REASONS FOR ALLOWANCE

The Examiner's Statement of Reasons for Allowance recites "Claims 1-25 are allowed since the applicants have amended claims to overcome enablement and indefiniteness rejections and furthermore, their arguments were persuasive regarding obviousness and obviousness-type double patenting rejections. Thus, all rejections are withdrawn."

Applicant recognizes that in accordance with M.P.E.P. § 1302.14, the Examiner's reasons for allowance need not set forth all of the details as to why the claims are allowed. In the above-referenced application, Applicant does not concede that the Examiner's stated reasons for allowance are the only reasons for which the claims are allowable. For example, none of the art of record, singly or in any combination thereof discloses, teaches or suggests compounds of formulae I or II as instantly claimed or pharmaceutical compositions thereof.

Applicant also respectfully submits that the recitation of "prodrug" in original claims 1 and 15 is in accord with the requirements of 35 U.S.C. § 112, first paragraph. Applicant respectfully submits that a patent application satisfies the requirements of 35 U.S.C. § 112, first paragraph, as long as it provides sufficient disclosure, either through illustrative examples or terminology, to teach those of skill in the art how to make and use the claimed subject matter without undue experimentation. Applicant respectfully submits that the art at the time of filing was replete with guidance for preparing and using prodrugs. See *e.g.*, Richard B. Silverman, *The Organic Chemistry of Drug Design and Drug Action*, Academic Press, Inc., (1992); Chapter 8: "Prodrugs and Drug Delivery Systems," pp 352-401. Silverman teaches various types of prodrugs and mechanisms of prodrug activation for compounds that include cyclic, bicyclic, tricyclic and multi-ring drugs. Silverman also teaches use of prodrugs for increasing solubility, adsorption and distribution, improving instability *in vivo*, prolonged release, minimizing toxicity, and improving formulation and patient acceptability. A patent application need not teach what is well known in the art. *Spectra-Physics, Inc. v. Coherent, Inc.*, 3 USPQ2d 1737 (Fed. Cir. 1987). In order to

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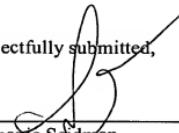
Attorney's Docket No.: 18202-048001 / 1087
Comments on Examiner's Reasons for Allowance

advance prosecution to allowance, but without acquiescing to the rejection, claims 1 and 15 were amended without prejudice or disclaimer to delete the recitation "or prodrug," and Applicant specifically reserved the right to file a continuation application directed to the cancelled subject matter.

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Entry of the above remarks into the record of the application is respectfully requested.

Respectfully submitted,


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